

RESPONSE

Applicant has carefully reviewed and considered the Office Action mailed on January 18, 2007.

Claims 1-34 are pending. Claims 3-4, 7, 10-12, 14 and 15-32 are withdrawn from consideration. Claims 1-2, 5-9 and 13 are rejected.

The Office Action does not address claims 33 and 34. Applicant notes that the Office Action Summary asserts that claims 1-32 are pending. This is not correct: claims 1-34 are pending, and both claims 33 and 34 are originally filed claims. The first paragraph of the Detailed Action recognizes Applicant's election of Group I, claims 10, 12, 14, 33-34, where the species is 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-NH₂. However, the Office Action does not thereafter address claims 33 and 34.

The second paragraph of the Detailed Action indicates that, among other compounds, the elected species 7'-amino-heptanoyl-Ser(Bzl)-D-Phe(4-Cl)-Arg-Trp-NH₂ was "found to be free of the prior art." Accordingly, claims 33 and 34 should have been allowed.

It is respectfully requested that the next office action indicate the examination and allowance of claims 33 and 34.

Claim Rejections – 35 USC § 102

Claims 1-2, 5, 6-9 and 13 are rejected under 35 USC § 102(b) as being anticipated by Sharma et al. (WO 01/13112). Reference is made to two compounds in the described reference comprising a Trp-Cys-NH₂ terminal group to establish anticipation.

The present application 10/756,212 is a continuation application of International Patent Application PCT/US02/22196, Publication No. WO 03/006620, which in turn claimed priority, as does the present application, to provisional patent application Serial No. 60/304,836, filed on July 11, 2001. The publication date of the cited § 102(b) reference, WO 01/13112, is 22 February 2001. Because § 102(b) requires that the invention be "described in a printed publication ... more than one year prior to the date of the application", if the disclosure of the provisional Serial No. 60/304,836 enables the pending claims, then the cited reference (WO 01/13112) cannot properly

be applied. As discussed below, provisional Serial No. 60/304,836 enables the pending claims.

At page 9 of provisional Serial No. 60/304,836, the group corresponding to S_5 , in that application called " R_5 ", is described as "an amino acid with an aromatic side chain, and optionally one or more additional amino acids, and further optionally a terminus [sic] group." This includes within its ambit a Trp-Cys-NH₂ terminal group. Even more definitively, at least three different examples are given in provisional Serial No. 60/304,836 which each have a Trp-Cys-NH₂ terminal group. See compound ID PL-2262 in Table 1 on page 11, and compound ID PL-2264 and PL-2266 in Table 2 on page 13. Indeed, PL-1949 described on page 47 in WO 01/13112 is the exact same amino acid sequence as PL-2262 in Table 1 on page 11 in provisional Serial No. 60/304,836, differing only in that the compound described in WO 01/13112 is further described as complexed to a rhenium metal ion, while PL-2262 in Table 1 on page 11 in provisional Serial No. 60/304,836 is not complexed to any metal ion. Clearly provisional Serial No. 60/304,836 enables the invention as claimed, and Applicant is entitled to rely on priority to the provisional. Accordingly, the § 102(b) rejection is improper.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (609 495 9197) to facilitate prosecution of this application.

A petition for a one month extension within which to respond is submitted herewith. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3582.

Respectfully submitted,

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